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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,294	09/23/2003	James L. Hobart	SCI-00602	4649

7590 03/15/2006

HAVERSTOCK & OWENS LLP  
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Sunnyvale, CA 94086

EXAMINER
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PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/669,294	<b>Applicant(s)</b> HOBART ET AL.	
	<b>Examiner</b> Michael Peffley	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 19-27, 29, 31, 48, 50-54 and 56-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-27, 29, 31, 48, 50-53, 57-63 and 66 is/are rejected.
- 7) ☒ Claim(s) 54, 56, 64 and 65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2006 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-27, 29, 31, 48, 50-53, 57-63 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motter et al (6,454,763) in view of the teaching of Colvard et al (5,738,677).

Motter et al disclose a laser probe device that comprises a laser source (not shown) and a laser applicator. The applicator includes a trunk optical fiber (13) for conveying laser light from the source to an endoprobe (12) and a delivery optical fiber (40) with an input end for receiving light from the trunk fiber (i.e. at connector 14) and delivering the light to tissue. Further, the endoprobe includes a shielding structure that includes a housing portion (32,36) surrounding the delivery optical fiber and a beam blocking portion (70) that forms a gap with the housing portion and blocks the forward

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transmission of laser energy (see Figure 4). While the handle portion of the endoprobe is generally rigid, Motter et al disclose the distal portion of the device to be flexible (col. 9, lines 25+) and the examiner maintains that the approach angle of the probe may be controlled to any desired angle by simply maneuvering the handle. It is noted that claim 48, for example, does not define an approach angle as being relative to the probe. The examiner is interpreting "approach angle" as being the angle between the probe tip (i.e. optical fiber) and tissue, which angle may clearly be controlled by providing the device at a particular orientation with respect to the tissue. Motter et al fail to disclose the specific pulse characteristics and optical fiber diameters as set forth in the claims.

Regarding the use of laser bursts, Motter et al disclose the use of pulses, but fails to specifically disclose pulse bursts. Colvard et al, as addressed in the previous Office action, disclose the use of laser bursts having pulse parameters within those set forth by the applicant. The Colvard et al device is used for treating ocular tissue, just as the Motter et al device is used. The size of the fiber as set forth by Colvard et al (col. 8, lines 30-40) and the pulse energies, frequencies and durations (col. 7, lines 25-35) are all deemed to be parameters that would be obviously used in the Motter et al system, particularly since the Motter et al device is used in analogous procedures.

Finally, the examiner maintains that the various materials used in making optical fibers, such as sapphire and silica, are generally well known in the art and are obvious design considerations for one of ordinary skill in the art.

It is deemed to be an obvious modification for one of ordinary skill in the art to have provided the Motter et al system with the particular laser pulse parameters as

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disclosed by Colvard et al for the treatment of ocular tissue, particularly since the Colvard et al and Motter et al systems are used for analogous procedures.

***Allowable Subject Matter***

Claims 54, 56, 64 and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to disclose the particular shrouded endo-probe that employs a side-firing (claims 54 and 56) or sliding (claims 64 and 65) optical fiber as set forth in these claims. Motter et al relies on the fiber being a forward firing, non-extending optical fiber to take advantage of the beam dump for trapping energy. Other side-firing probes (e.g. Vassiliadis et al and Colvard et al) have no need for the forward shield as the laser energy is directed in a lateral direction.

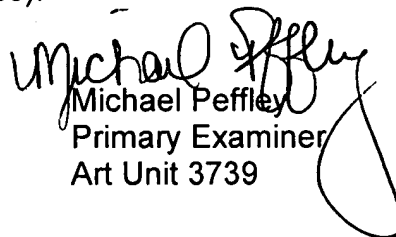
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
March 10, 2006